



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,180	02/12/2001	Anthony L. Millin	9732-022	2777

116 7590 09/14/2004

PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
----------	--------------

2145

DATE MAILED: 09/14/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

14

Office Action Summary

Application No.

09/781,180

Applicant(s)

MILLIN ET AL.

Examiner

Patrice Winder

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Compact Disc Submission

1. The description portion of this application contains a computer program listing consisting of more than three hundred (300) lines. In accordance with 37 CFR 1.96(c), a computer program listing of more than three hundred lines must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(b)(4)). Accordingly, applicant is required to cancel the computer program listing appearing in the specification on pages 4-52, file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c) and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 18, and 29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The abbreviation PRC was not defined before its first use in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-6, 10, 12-13, 15-16, 19, 21, 23-24, 26 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al., USPN 6,085,249 (hereafter referred to as Wang_2).

6. Regarding claim 1, Wang_2 taught a plug-in computer program stored on a local host computer for transferring data between an input device and a remotely located computer that is connected to said local host computer by computer network (column 13, lines 53-56), comprising:

(a) software for receiving data from said input device (column 4, lines 59-62, column 9, lines 41-46);

(b) software for formatting said received data so that it can be transferred over said computer network to said remotely-located computer (column 5, lines 24-34); and

(c) software for transmitting said received data to said remotely located computer over said computer network (column 5, lines 35-36).

7. Regarding dependent claim 2, Wang_2 taught said computer network is the Internet and said remotely located computer is a web server (column 4, lines 1-9).

Art Unit: 2145

8. Regarding dependent claim 4, Wang_2 taught said input device is a digital camera (column 9, lines 41-46).

9. Regarding dependent claim 5, Wang_2 taught said local host computer is an Internet-enabled computer connected to said remotely located computer via the Internet (column 4, lines 1-9).

10. Regarding dependent claim 6, Wang_2 taught said program is a browser plug-in (column 13, lines 53-56).

11. Regarding dependent claim 10, Wang_2 taught said browser plug-in comprises software that enables communication based on a communications protocol specific to the input device (column 13, lines 53-61, column 14, lines 11-19).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 7-8, 14, 17-18, 25 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang_2 in view of Shiigi et al., USPN 6,304,898 B1 (hereafter referred to as Shiigi).

14. Regarding dependent claim 3, Wang_2 does not specifically teach said input device is a digitizer pad. However, Shiigi taught an input device is a digitizer pad (column 4, lines 13-25). It would have been obvious to one of ordinary skill in the art at

Art Unit: 2145

the time the invention was made that incorporating Shiigi's digitizer pad in Wang_2 system for uploading data to a web server would have improved system effectiveness.

The motivation would have been to enable people to communicate in their own handwriting or drawings (Shiigi, column 2, lines 7-9).

15. Regarding dependent claim 7, Wang_2 does not specifically teach said host computer is an Internet-enabled personal digital assistant. However, Shiigi taught a host computer is an Internet-enabled personal digital assistant (column 3, lines 35-38, column 3, lines 49-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Shiigi's personal digital assistant in Wang_2 system for uploading data to a web server would have improved system effectiveness. The motivation would have been to enable people to communicate in using their own drawings (Shiigi, column 2, lines 7-9).

16. Regarding dependent claim 8, However, Shiigi taught a plug-in computer program is a PRC (column 9, lines 8-11).

17. Claims 9, 11, 20, 22, 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang_2 in view of Wang et al., USPN 6,058,428 (hereafter referred to as Wang).

18. Regarding dependent claim 9, Wang_2 does not specifically teach downloading said browser plug-in. However, Wang taught a browser plug-in is downloaded to said local host computer via the Internet (column 6, lines 52-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Wang's plug-in Wang_2's system for uploading data to a web server would have

expanded system functionality. The motivation would have been to extend the browser functionality to include desired specialized function without modifying the browser software.

19. Regarding dependent claim 11, Wang_2 does not specifically teach an HTML POST command. However, Wang taught formatted data is packaged into an HTML POST command data packet (column 5, lines 38-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Wang's HTML POST command in Wang_2's system for uploading data to a web server would have provided equivalent functionality. The motivation would have been to use a well know feature of hypertext transfer protocol (HTTP).

20. The language of claims 12-31 is substantially the same as previously rejected claims 1-11, above. Therefore, claims 12-31 are rejected on the same rationale as previously rejected claims 1-11, above.

Conclusion


21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Narayan et al., USPN 6,035,323: a system for publishing a collection of digital media on a network to a web server that includes software for serving the collection of digital media.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 703-305-3938. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2145

September 10, 2004